



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,902	10/30/2003	Alberto Rodriguez	A3026-US-NP XERZ 2 02200	9247
62095 7590 11/24/2009 FAY SHARPE / XEROX - ROCHESTER 1228 EUCLID AVENUE, 5TH FLOOR THE HALLE BUILDING CLEVELAND, OH 44115			EXAMINER DHINGRA, PAWANDEEP	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 11/24/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/696,902	Applicant(s) RODRIGUEZ ET AL.	
	Examiner PAWANDEEP S. DHINGRA	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the following communication: Amendment after non-final action filed on 7/15/2009.
- Claims 1-25 are pending.

Response to arguments

Applicant's arguments filed on 7/15/2009 have been fully considered but they are not persuasive.

Applicant argues that logical component 144 as cited under Owen does not sufficiently teach a processor. Applicant argues that logical component can be an On/Off switch as one example.

In reply, examiner asserts that both logical component and S412, fig. 4 were cited for the processor part in Owen. Although Owen does not explicitly states a logical component being a processor, it also does not state that logical component is one of the components as mentioned by the applicant. But step 412 in fig. 4 clearly teaches that replaceable component has a processor element inside it (also see claim 4).

Applicant further argues that Hirst only teaches a consumable memory and fails to teach a non-consumable memory.

In reply, examiner asserts that first the applicant's specification does not mention non-consumable memory or defines what applicant means by it. Specification mentions non-volatile memory 68 similar as the Hirst's EEPROM 33 memory for holding upgrade information. Furthermore, Hirst does not mention anything about disposing off the memory after using it once as seems to be argues by the applicant. Thus, Hirst

Art Unit: 2625

successfully teaches the non-consumable memory similar to as mentioned in applicant's specification.

Applicant further argues that improper hindsight is used by the examiner since examiner used sheer volume of references (five references) to reject dependents claims 6-22.

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Applicant is claiming various variations of the well known and commonly used techniques in the art and number of references were brought in to read on those well known methods since it is hard to find one reference to mention all the well known techniques used in the art since a lot of features as claimed for which different references were used do not seem pertinent and are commonly known in the art.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Claim Objections

Previous objection(s) to claim(s) have been withdrawn in view of applicant's amendments to the claim(s).

Specification

The amendment filed 11/25/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Claim 1 recites the limitation "ceasing operation of the printing apparatus". This limitation is not supported by the specification.

Claim 9 recites the limitation "non-consumable memory". This limitation is not supported by the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

Art Unit: 2625

the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites the limitation "ceasing operation of the printing apparatus". This limitation is not supported by the specification.

Claim 9 recites the limitation "non-consumable memory". This limitation is not supported by the specification.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites the limitation "ceasing operation of the printing apparatus". This limitation is not supported by the specification.

Claim 9 recites the limitation "non-consumable memory". This limitation is not supported by the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2625

Claim 1 recites "so that no other individual needs..." This limitation lacks antecedent basis as it's unclear who the first individual is?

Claim Objections

6. Claim 14 is objected to because of the following informalities: claim 14 recites "comprised of" two times. Also there is no antecedent basis for "the internet". Appropriate corrections are required.

Examiner Notes

Examiner cites particular paragraphs, columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2625

8. Claims 1-4, 7, 9-15 are rejected under 35 U.S.C. 103 as being unpatentable over Richards et al., US 6,532,351 in view of Owen et al., US 2004/0080775 further in view of Hirst et al., US 5,930,553 further in view of Hara, US 2004/0045000.

Re claim 1, Richards et al. discloses a replaceable module (removable module, see abstract) for a printing apparatus (printer 10, fig. 1) with programmable software controls (see figure 2 with text; abstract, note chip is programmable), the module comprising: an internal memory (memory 34, fig. 2) for holding stored instructions (see abstract; column 4, lines 4-64) (see also column 3, line 20-column 5, line 32); a communications interface (RF loop 30, fig. 2) for exchanging information with the printing apparatus (see figures 1-2; abstract; column 5, line 33-column 6, line 9); and, a microprocessor (microchip or Integrated Circuit, see element 32, figure 2) connected to the internal memory (element 34, figure 2), and the communications interface (element 30, figure 2) (see column 5, line 33-column 6, line 56).

Richards et al. fails to explicitly disclose the module comprising: a peripheral memory holding a software upgrade for the printing apparatus programmable software controls; and a microprocessor connected to peripheral memory, the microprocessor performing the stored instructions to compare currently installed software and current machine status with available software upgrades to determine if the software upgrade is appropriate for installation and if an upgrade is appropriate, then install the software upgrade into the printing apparatus via the communications interface when the replaceable module is installed in the printing apparatus by ceasing operation of the printing apparatus, upgrading software by extracting necessary components from a web

Art Unit: 2625

based source or from an internal memory source, monitor progress of the upgrade, report any faults, contact service personnel if the upgrades is not successfully completed, and return the printing apparatus to normal operation when the software upgrade is complete so that no other individual needs to perform the software upgrade for the printing apparatus.

However, Owen et al. teaches a replaceable module (replaceable component 12B, see fig. 3), the module comprising: a microprocessor (S412, fig. 4, note that replaceable component has a microprocessor in it) connected to an internal memory (element 1462, fig. 3), a peripheral memory (element 1464, fig. 3) and a communications interface (element 142, fig. 3) (see paragraphs 23-24, 27).

Hirst et al. teaches a replaceable module (consumable device such as toner cartridge 18 is installed in a printing apparatus 10, fig. 1), see col. 4, lines 45-50) for a printing apparatus (printer 10, fig. 1) with programmable software controls (see col. 4, lines 45-67, col. 2, lines 32-65), the module comprising: a peripheral memory (consumable memory device 19, fig. 1) holding a software upgrade for the printing apparatus programmable software controls (see column 4, line 45-column 5, line 65) (see also column 2, line 55-column 3, line 33); and a microprocessor (microcomputer 30, fig. 3) connected to a internal memory (elements 31-33, fig. 3), a peripheral memory (element 19, fig. 1, note that element 30 is connected to element 19) and a communications interface (interface between elements 30 & 19, fig. 1 and buses 35-36, fig. 3) (see figs. 1 & 3 with text), the microprocessor performing the stored instructions to compare currently installed software and current machine status with available

Art Unit: 2625

software upgrades to determine if the software upgrade is appropriate for installation and if an upgrade is appropriate, then install the software upgrade into the printing apparatus via the communications interface when the replaceable module is installed in the printing apparatus (see col. 3, lines 34-54; col. 4, lines 45-67; col. 5, line 54-col. 6, line 12; figures 4-6, note if new consumable is identified based on comparison methods shown after installation and contains the desired code patch than the necessary software patches are installed into image forming device. Further, note that the microprocessor 30 checks the current machine status to see if new consumable is detected and checks consumable memory 19 for updates. If updates appear to be new as compared to the currently installed software updates in the printing apparatus 10 then downloads and installs the new updates from consumable memory 19 into printing apparatuses nonvolatile EEPROM 33 memory) by ceasing operation of the printing apparatus, upgrading software by extracting necessary components from a web based source or from an internal memory source (memory device 19 within the housing of consumable 18), and return the printing apparatus to normal operation when the software upgrade is complete (note that microcomputer 30 within printer controller 13 controls all the functions of the printing apparatus 10, and it is quite apparent and well known in art that while downloading and installing new updates, microcomputer 30 constitutes its resources towards that task and ceasing normal operations of the printer until the completion of necessary upgrading) so that no other individual needs to perform the software upgrade for the printing apparatus (see column 2, lines 4-65; column 3, lines 34-54), (see also column 5, line 54-column 6, line 12).

Art Unit: 2625

Hara teaches monitoring progress of the upgrade (installer containing software package), reporting any faults (error message), contacting service personnel (user of device 1) if the upgrades is not successfully completed (see figs. 6-7 with text, note that controller monitors a installer request and whether a software package has been successfully installed; it gives a error message to the user if software package cannot be downloaded and installed (i.e. since it has already been installed previously)).

It would have been advantageous to modify the replacement module and its system as disclosed by Richards to include the techniques for operating printing consumables as taught by Owen and Hirst and software updating techniques as taught by Hara for the benefit of having "improved methods, replaceable components, and systems that provide communication with memory in a replaceable component without requiring a printing device" as taught by Owen in paragraph 3, and "to provide more direct communication with the manufacturers of the consumable components regarding the consumption rates, installation and exhaustion dates and other key information. Additionally, it would be advantageous to be able to provide software patches and updates to the office automation and image forming devices. Also, it would be advantageous to provide a robust two way communications link between a host device and image forming and office automation devices" as taught by Hirst at column 2, lines 19-29 and preventing unnecessary consumption of resources for performing duplicate software installations as taught by Hara at paragraph 49. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention to combine the

Art Unit: 2625

apparatus of Richards with the apparatuses of Owen, Hirst and Hara to reach the aforementioned advantage.

Re claim 2, Richards et al. further discloses the communications interface comprises a wired communication element (see column 5, line 33-column 7, line 14).

Re claim 3, Richards et al. further discloses the communications interface comprises a wireless communication element (see column 5, line 33-column 7, line 14).

Re claim 4, Richards et al. fails to further disclose a peripheral memory interface, where the microprocessor is connected to the peripheral memory through the peripheral memory interface.

However, Owen et al. teaches a peripheral memory interface, where the microprocessor is connected to the peripheral memory through the peripheral memory interface (see figures 3-4 with text).

Hirst et al. also teaches a peripheral memory interface, where the microprocessor is connected to the peripheral memory through the peripheral memory interface (note, interface between elements 30 & 19, fig. 1, see fig. 1 with text).

Re claim 7, Richards et al. fails to further disclose the peripheral memory comprises nonvolatile integrated circuit chip memory.

However, Owen teaches the peripheral memory comprises nonvolatile integrated circuit chip memory (see figure 3; paragraph 18).

Hirst et al. also teaches the peripheral memory comprises nonvolatile integrated circuit chip memory (see col. 2, lines 55-65, col. 4, line 45-column 5, line 24).

Re claim 9, Richards et al. discloses a printing apparatus (printer 10, fig. 1), a method of operating a replaceable module (removable module, see abstract; claims 1-2), the method comprising: installing the replaceable module in the printing apparatus (see abstract, figures 1-3, claims 1-2).

Richards et al. fails to further disclose allowing a processor element on board the replaceable module to interrogate the printing apparatus, wherein interrogating includes identifying previously installed replaceable modules; determining which software components in the printing apparatus need to be upgraded by comparing software currently installed in the printing apparatus with available software upgrades; accessing internal, non-consumable memory to retrieve and load any necessary software code components for an upgrade; installing the software code into the printing apparatus by the processor element in the replaceable module so that a field engineer or other individual need not perform the software upgrade for the printing apparatus; monitoring the progress of the software upgrade; reporting any fault occurring during the upgrade; placing a service call if the upgrade is unsuccessful; and returning the printing apparatus to normal operating mode when the software upgrade is complete.

However, Owen et al. teaches allowing a processor element on board the replaceable module to interrogate the printing apparatus (see element 144 in fig. 3; element 412 in fig. 4; paragraph 27; claim 4, note that processor interrogates the

Art Unit: 2625

memory of printing apparatus for which application to execute according to the request made by the host). Owen further discloses installing the replaceable module in the printing apparatus; the replaceable module comprising a processor element (see element 412 in fig. 4; claim 4) and executing an software application by the processor element (see figures 3-4 with corresponding text; claim 4).

Hirst et al. teaches allowing a processor element (microcomputer 30, figs. 1, 3) to interrogate the printing apparatus (image forming device 10, fig. 1), wherein interrogating includes identifying previously installed replaceable modules (see column 3, lines 16-54; column 4, line 45-column 6, line 20, note that the microcomputer within the printer controller 13 interrogates previously stored consumable identification number and identifies newly installed consumables from previously installed consumables); determining which software components in the printing apparatus (image forming device 10, fig. 1) need to be upgraded (see figures 4-6, column 3, lines 34-54; column 5, lines 54-65) by comparing software currently installed in the printing apparatus with available software upgrades (see col. 3, lines 34-54; col. 4, lines 45-67; col. 5, line 54-col. 6, line 12; figures 4-6, note if new consumable is identified based on comparison methods shown after installation and contains the desired code patch than the necessary software patches are installed into image forming device. Further, note that the microprocessor 30 checks the current machine status to see if new consumable is detected and checks consumable memory 19 for updates. If updates appear to be new as compared to the currently installed software updates in the printing apparatus 10 then downloads and installs the new updates from consumable memory 19 into printing

Art Unit: 2625

apparatuses nonvolatile EEPROM 33 memory); accessing internal, non-consumable memory (memory 19 within consumable 18) to retrieve and load any necessary software code components for an upgrade (see figures 4-6; column 3, lines 34-54; column 5, lines 54-65); installing the software code into the printing apparatus by the processor element (microcomputer 30, figs. 1, 3) in the printing apparatus (see column 3, lines 34-54; column 4, line 45-column 6, line 20, note if new consumable is identified based on comparison methods shown and contains the desired code patch than the necessary software patches are installed into image forming device) so that a field engineer or other individual need not perform the software upgrade for the printing apparatus (see column 2, lines 4-65; column 3, lines 34-54), (see also column 5, line 54-column 6, line 20); returning the printing apparatus to normal operating mode when the software upgrade is complete (note that microcomputer 30 within printer controller 13 controls all the functions of the printing apparatus 10, and it is quite apparent and well known in art that while downloading and installing new updates, microcomputer 30 constitutes its resources towards that task and ceasing normal operations of the printer until the completion of necessary upgrading) so that no other individual needs to perform the software upgrade for the printing apparatus (see column 2, lines 4-65; column 3, lines 34-54), (see also column 5, line 54-column 6, line 12).

Hara teaches monitoring the progress of the software upgrade (installer containing software package); reporting any fault (error message) occurring during the upgrade; placing a service call (message is sent and displayed on user of device 1) if the upgrade is unsuccessful (see figs. 6-7 with text, note that controller monitors a

Art Unit: 2625

installer request and whether a software package has been successfully installed; it gives a error message to the user if software package cannot be downloaded and installed (i.e. since it has already been installed previously), the error message is displayed on the user's machine).

It would have been advantageous to modify the replacement module and its system as disclosed by Richards to include the techniques for operating printing consumables as taught by Owen and Hirst and software updating techniques as taught by Hara for the benefit of having "improved methods, replaceable components, and systems that provide communication with memory in a replaceable component without requiring a printing device" as taught by Owen in paragraph 3, and "to provide more direct communication with the manufacturers of the consumable components regarding the consumption rates, installation and exhaustion dates and other key information. Additionally, it would be advantageous to be able to provide software patches and updates to the office automation and image forming devices. Also, it would be advantageous to provide a robust two way communications link between a host device and image forming and office automation devices" as taught by Hirst at column 2, lines 19-29 and preventing unnecessary consumption of resources for performing duplicate software installations as taught by Hara at paragraph 49. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention to combine the apparatus of Richards with the apparatuses of Owen, Hirst and Hara to reach the aforementioned advantage.

Art Unit: 2625

Re claim 10, Richards et al. fails to further disclose the processor element is a microprocessor.

However, Owen et al. discloses the processor element is a microprocessor (see paragraph 27, note that processor is a microprocessor).

Re claim 11, Richards et al. discloses the memory that is accessed is internal (see column 5, line 33-column 6, line 56).

Hirst et al. discloses the memory that is accessed is internal (see figures 4-6).

Owen et al. discloses accessing the internal memory (see figures 3-4 with text).

Re claim 12, Richards et al. fails to further disclose the memory that is accessed is external.

Hirst et al. discloses the memory that is accessed is external (see figures 4-6; column 4, line 45-column 5, line 65).

Owen et al. also discloses accessing the external memory (see figures 3-4 with text).

Re claim 13, Richards et al. further discloses the memory is accessed via a network connection (see column 5, line 33-column 7, line 14).

Hirst et al. also teaches the memory is accessed via a network connection (see figs. 1, 3 with text and fig 5).

Owen et al. also teaches accessing the memory via a network connection (see figures 3-4 with text).

Re claim 14, Hirst et al. further teaches the network connection is comprised of the internet (see col. 6, lines 17-21).

Re claim 15, Richards et al. further discloses the network connection access is accomplished by a wireless communication element (see column 5, line 33-column 7, line 14).

9. Claims 5-6, and 8 are rejected under 35 U.S.C. 103 as being unpatentable over Richards et al., US 6,532,351 in view of Owen et al., US 2004/0080775 further in view of Hirst et al., US 5,930,553, further in view of Hara, US 2004/0045000 further in view of well known art.

Re claim 5, 6 & 8, Richards fails to further disclose that the peripheral memory comprises flash memory, flashcards or bubble memory.

Owen discloses "Other fixed media and removable media memory devices 28 are optionally included in host computer 20D. The memories 22 and 28, which provide data storage mechanisms, can be read-only memory (ROM), random access memory (RAM), a hard drive, a floppy disk drive, a CD-ROM drive, and other conventional memory device" (see paragraph 18).

However, Official Notice is taken to note that ability to use variety of different types of memory's is notoriously well known and commonly used in the art. It would

Art Unit: 2625

have been obvious to include a flash memory, flashcards or bubble memory as non-volatile peripheral memory or as removable media memory devices 28 in the system of Owen for the benefit of providing the user with increased flexibility and options to use other conventional memory devices (see Owen, paragraph 18).

It would have been advantageous to modify the replacement module and its system as disclosed by Richards to include the techniques for operating printing consumables as taught by Owen and Hirst and software updating techniques as taught by Hara for the benefit of having "improved methods, replaceable components, and systems that provide communication with memory in a replaceable component without requiring a printing device" as taught by Owen in paragraph 3, and "to provide more direct communication with the manufacturers of the consumable components regarding the consumption rates, installation and exhaustion dates and other key information. Additionally, it would be advantageous to be able to provide software patches and updates to the office automation and image forming devices. Also, it would be advantageous to provide a robust two way communications link between a host device and image forming and office automation devices" as taught by Hirst at column 2, lines 19-29 and preventing unnecessary consumption of resources for performing duplicate software installations as taught by Hara at paragraph 49. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention to combine the apparatus of Richards with the apparatuses of Owen, Hirst and Hara to reach the aforementioned advantage.

Art Unit: 2625

10. Claims 16-22 are rejected under 35 U.S.C. 103 as being unpatentable over Richards et al., US 6,532,351 in view of Owen et al., US 2004/0080775 further in view of Rasche et al., US 7,262,873 further in view of McIntyre, US 2003/0063305 further in view of Hirst et al., US 5,930,553 further in view of Hara, US 2004/0045000.

Re claim 16, Richards et al. discloses a printing apparatus (see figure 1), a method of operating a replaceable module, the method comprising: installing the replaceable module in the printing apparatus (see abstract, figures 1-3, claims 1-2).

Richards fails to further disclose a method of operating a replaceable module having a processor element on board the replaceable module, the method comprising: placing the printing apparatus into diagnostic mode; allowing a processor element on board the replaceable module to interrogate the printing apparatus; determining from the interrogation which software components in the printing apparatus need to be upgraded; scheduling as determined by the processor element when a software upgrade should occur; accessing memory as directed by the processor element in order to retrieve and load necessary software code components to perform an upgrade; installing the software code into the printing apparatus by the processor element in the replaceable module; monitoring the progress of the software upgrade; reporting any fault occurring during the upgrade; placing a service call if the upgrade is unsuccessful; and returning the printing apparatus to normal operating mode when the software upgrade is complete.

However, Owen discloses a method of operating a replaceable module having a processor element on board the replaceable module (see abstract figures 3-4; element 144 in fig. 3; element 412 in fig. 4; paragraph 27, claim 4), the method comprising: allowing a processor element on board the replaceable module to interrogate the printing apparatus (see figures 3-4, paragraph 27). Owen further discloses installing the replaceable module in the printing apparatus; the replaceable module comprising a processor element (see claim 4; element 412 in fig. 4) and executing a software application by the processor element (see figures 3-4 with corresponding text; claim 4).

Rasche et al. discloses placing the printing apparatus (photocopier 30) into diagnostic mode before allowing a processor element of server 50 to interrogate the printing apparatus (see column 2, lines 8-15; column 8, lines 15-48).

McIntyre discloses scheduling as determined by the processor element (see paragraphs 21, 36) when a software upgrade should occur (see paragraphs 13, 37; claim 10).

Hirst et al. discloses installing the replaceable module (consumable device such as toner cartridge 18, see col. 4, lines 45-50) in the printing apparatus (printer 10, fig. 1) (see col. 4, lines 45-67, col. 2, lines 32-65); interrogating the printing apparatus (see figures 4-6); determining from the interrogation which software components in the printing apparatus need to be upgraded (see figures 4-6) (see also column 3, lines 34-54; column 5, lines 54-65); accessing memory as directed by the processor element (microcomputer 30, figs. 1, 3) in order to retrieve and load any necessary software code

Art Unit: 2625

components for to perform upgrade (see figures 4-6; column 3, lines 34-54; column 5, lines 54-65); and, installing the software code into the printing apparatus by the processor element in the printing apparatus (see column 3, lines 34-54; column 4, line 45-column 6, line 20, note if new consumable is identified based on comparison methods shown and contains the desired code patch than the necessary software patches are installed into image forming device); returning the printing apparatus to normal operating mode when the software upgrade is complete (note that microcomputer 30 within printer controller 13 controls all the functions of the printing apparatus 10, and it is quite apparent and well known in art that while downloading and installing new updates, microcomputer 30 constitutes its resources towards that task and ceasing normal operations of the printer until the completion of necessary upgrading) so that no other individual needs to perform the software upgrade for the printing apparatus (see column 2, lines 4-65; column 3, lines 34-54), (see also column 5, line 54-column 6, line 12).

Hara teaches monitoring the progress of the software upgrade (installer containing software package); reporting any fault (error message) occurring during the upgrade; placing a service call (message is sent and displayed on user of device 1) if the upgrade is unsuccessful (see figs. 6-7 with text, note that controller monitors a installer request and whether a software package has been successfully installed; it gives a error message to the user if software package cannot be downloaded and installed (i.e. since it has already been installed previously)).

Art Unit: 2625

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention to modify the replacement module and its system as disclosed by Richards to include the techniques for operating printing consumables as taught by Owen and Hirst, software updating techniques as taught by Hara, printer diagnostics techniques as taught by Rasche, and techniques for updating printer's firmware as taught by McIntyre for the benefit of having "improved methods, replaceable components, and systems that provide communication with memory in a replaceable component without requiring a printing device" as taught by Owen in paragraph 3, to provide an improved stand-alone printer which when diagnosed can provide useful statistical data as taught by Rasche at column 2, lines 8-15; column 8, lines 15-63, "to provide a system whereby customized, default printer control panel settings are restored while minimizing losses in material or human resources resulting from changed default settings. Preferably, such a system would enable both automatic and manual restoration or reconfiguration of the control panel settings of one or more printers. Additionally, the ability to allow a user to restore or reconfigure the control panel settings of one or more printers without having to individually adjust the control panel settings of each of the affected printers is desirable" as taught by McIntyre in paragraph 8, and "to provide more direct communication with the manufacturers of the consumable components regarding the consumption rates, installation and exhaustion dates and other key information. Additionally, it would be advantageous to be able to provide software patches and updates to the office automation and image forming devices. Also, it would be advantageous to provide a robust two way communications link

Art Unit: 2625

between a host device and image forming and office automation devices" as taught by Hirst at column 2, lines 19-29, and preventing unnecessary consumption of resources for performing duplicate software installations as taught by Hara at paragraph 49.

Claims 17-22, claims 17-22 are essentially similar to claims 10-15 and are rejected on the same grounds (see explanation of claims 10-15 given above).

11. Claims 23-25 are rejected under 35 U.S.C. 103 as being unpatentable over Richards et al., US 6,532,351 in view of Owen et al., US 2004/0080775 further in view of Rasche et al., US 7,262,873 further in view of McIntyre, US 2003/0063305 further in view of Hirst et al., US 5,930,553 further in view of Hara, US 2004/0045000 further in view of well known art.

Re claim 23, Richards fails to further disclose the interrogation further comprises gathering machine and software version indicia, model number, serial number, and other identifying information, as would be desirable for completing an inventory of machines in the field.

Rasche et al. discloses interrogating the printing apparatus (photocopier 30) (see column 8, lines 15-48) wherein the interrogation further comprises gathering machine (check on electronic hardware) and software version indicia (code version), and other identifying information, as would be desirable for completing an inventory of machines in the field (see column 8, lines 15-48). Rasche fails to explicitly teach gathering the machine model number, and serial number.

However, Official Notice is taken to note that ability to gather model number, and serial number of a machine in addition to other information pertaining to performing software update checks is notoriously well known and commonly used in the art. It would have been obvious to gather machine model number, and serial number in addition to other identifying information in the system of Rasche for the benefit of keeping track of which serial and model number machines have been updated or need software updates (see Rasche, column 8, lines 15-63).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention to modify the replacement module and its system as disclosed by Richards to include the techniques for operating printing consumables as taught by Owen and Hirst, software updating techniques as taught by Hara, printer diagnostics techniques as taught by Rasche, and techniques for updating printer's firmware as taught by McIntyre for the benefit of having "improved methods, replaceable components, and systems that provide communication with memory in a replaceable component without requiring a printing device" as taught by Owen in paragraph 3, to provide an improved stand-alone printer which when diagnosed can provide useful statistical data as taught by Rasche at column 2, lines 8-15; column 8, lines 15-63, "to provide a system whereby customized, default printer control panel settings are restored while minimizing losses in material or human resources resulting from changed default settings. Preferably, such a system would enable both automatic and manual restoration or reconfiguration of the control panel settings of one or more printers. Additionally, the ability to allow a user to restore or reconfigure the control panel settings

Art Unit: 2625

of one or more printers without having to individually adjust the control panel settings of each of the affected printers is desirable" as taught by McIntyre in paragraph 8, and "to provide more direct communication with the manufacturers of the consumable components regarding the consumption rates, installation and exhaustion dates and other key information. Additionally, it would be advantageous to be able to provide software patches and updates to the office automation and image forming devices. Also, it would be advantageous to provide a robust two way communications link between a host device and image forming and office automation devices" as taught by Hirst at column 2, lines 19-29, and preventing unnecessary consumption of resources for performing duplicate software installations as taught by Hara at paragraph 49.

Re claim 24, Richards fails to further disclose the identifying information is passed via the network connection.

However, Rasche et al. further discloses the identifying information is passed via the network connection (see column 3, lines 14-36; column 8, lines 15-48).

Re claim 25, Richards fails to further disclose the identifying information is stored in memory on the replaceable module.

Hirst et al. discloses the identifying information (user settings) is stored in memory on the replaceable module (see figure 5).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAWANDEEP S. DHINGRA whose telephone number is (571)270-1231. The examiner can normally be reached on M-F, 9:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. D./

Examiner, Art Unit 2625

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625